

Appln No. 09/632,315
Amdt date September 2, 2003
Reply to Office action of April 2, 2003

REMARKS/ARGUMENTS

Claims 1, 3-14, 37-39, 46 and 48 are pending in this application. Claims 1, 3 and 4 have been allowed. Claims 5-14, 37-39, 46 and 48 have been rejected. Applicant respectfully requests re-examination, reconsideration and allowance of all pending claims.

Applicant would first like to take this opportunity to thank Examiner Danton DeMille for the opportunity given Mark J. Marcelli, undersigned counsel of record, to discuss the application in a telephonic Examiner Interview with Examiner DeMille which took place on May 15, 2003.

I. Claims 1, 3 and 4

Applicant acknowledges with appreciation the Examiner's indication that claims 1, 3 and 4 have been allowed.

II. Objection to the Specification

In the subject Office action, particularly in paragraph 1, the disclosure was objected to because "the C-shaped guide rail doesn't appear to be adequately disclosed in the drawings". Applicant respectfully submits that this objection to the specification is obviated for the reasons set forth below.

FIG. 23 has been added to illustrate the C-shaped guide rail and is attached hereto. Since the C-shaped guide rails were disclosed in the originally-filed specification, for example, on page 18, lines 29-31 and in originally-filed claims 46 and 48, no new matter has been added. The specification and drawings now each adequately disclose an exemplary C-shaped

Appln No. 09/632,315
Amdt date September 2, 2003
Reply to Office action of April 2, 2003

guide rail and therefore the objection to the specification should be withdrawn.

III. Rejection of Claims 5 and 48 Under 35 U.S.C. § 102(b)

In the subject Office action, particularly in paragraph 3, claims 5 and 48 were rejected under 35 U.S.C. § 102(b) as being anticipated by Goodman (U.S. Patent No. 4,586,493). Applicant respectfully submits that these claim rejections are overcome based on the reasons set forth below.

Independent claims 5 and 48 have been amended. Each of independent claims 5 and 48 generally recite the feature of a raceway having a V-shaped cross section. In particular, claim 5 recites the feature of "a first raceway having a generally V-shaped cross sectional shape" and claim 48 recites the feature of "the guide rail including a raceway having a generally V-shaped cross section". The cited reference of Goodman does not disclose a V-shaped raceway, but rather is limited to rails (22 and 23) that are flat. Therefore, claims 5 and 48 each recite features not disclosed by Goodman and claims 5 and 48 are therefore distinguished from Goodman.

Independent claims 5 and 48 also generally include the further feature that the force applied by a biasing member combines with the V-shaped raceway to center the guide wheel. In particular, claim 5, in addition to reciting the above features, further recites the feature of "wherein force applied by the biasing member and the shape of the first raceway center the guide wheel within the first raceway". Independent claim 48 recites the feature of "wherein force applied by the biasing

Appln No. 09/632,315
Amdt date September 2, 2003
Reply to Office action of April 2, 2003

member and the V-shaped cross section of the raceway center the guide wheel within the raceway". Goodman does not teach centering of the guide wheels, much less the shape of the raceway or rails centering the guide wheels. Since Goodman further does not disclose or suggest a raceway with a V-shaped cross section, Goodman cannot and does not teach the above cited feature.

Since independent claims 5 and 48 recite features that are not taught by Goodman, the rejection of claims 5 and 48 under 35 U.S.C. § 102(b) as being anticipated by Goodman, should be withdrawn.

Furthermore, applicant respectfully submits that there is nothing in Goodman to suggest the above features.

The Goodman reference is directed to a therapy table. Applicant respectfully points out that it would be impermissible hindsight reconstruction to combine the teachings of Goodman with the teachings of a reference that is outside the subject matter of the Goodman reference, such as a panel door assembly (please refer to the discussion under Section V, below) to make up for the above-stated deficiencies of Goodman.

IV. Rejection of Claim 46 Under 35 U.S.C. § 102(b)

In the subject Office action, particularly in paragraph 4, claim 46 was rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Ookawa, et al. (U.S. Patent No. 5,792,080), hereinafter "Ookawa". Applicant respectfully submits that this claim rejection is overcome based on the reasons set forth below.

Appln No. 09/632,315
Amdt date September 2, 2003
Reply to Office action of April 2, 2003

Independent claim 46 has been amended and now recites the feature: "a retainer coupled to the massaging member for constraining the massaging member to only a sideward oscillating motion". Applicant respectfully submits that Ookawa does not teach or suggest such a feature. Moreover, the May 16, 2003 Examiner Interview Summary (copy attached) indicates that "Claims limited to recite that the retainer constrains the massaging member to "only" sideward motion would appear to define over Ookawa". Therefore, amended claim 46 is distinguished from the Ookawa reference and the rejection of claim 46 as being anticipated by Ookawa, should be withdrawn.

Claim 46 is in allowable form.

V. Rejection of Claims 6, 8-10 and 37 Under 35 U.S.C. § 103(a)

In the subject Office action, particularly paragraph 5, claims 6, 8-10 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goodman in view of Haley (U.S. Patent No. 3,854,165). Applicant respectfully submits that these claim rejections are overcome based on the reasons set forth below.

The Goodman reference discloses a therapy table and the Haley reference is directed to a panel door assembly that is outside of the subject matter of the present invention and outside of the subject matter of the Goodman reference. Applicant respectfully submits that there is no teaching or motivation whatsoever as to how or why a massaging device should be combined with a panel door assembly. As such, one of ordinary skill in the art would therefore not look to the Haley reference to modify the device disclosed in Goodman. Applicant

Appln No. 09/632,315
Amdt date September 2, 2003
Reply to Office action of April 2, 2003

further submits that to combine the teachings of a therapy table, i.e., Goodman, with the teachings of a panel door assembly, i.e. Haley, to arrive at the claimed invention, is impermissible hindsight reconstruction.

When an obviousness determination depends on a selective combination of prior art references, there must be some reason for a combination other than hindsight gleaned from the invention itself. The prior art under consideration must contain a teaching or motivation or incentive or suggestion to do so. The relevant legal principal was stated precisely in Northern Telecom, Inc. v. Datapoint Corp., 15 U.S.P.Q. 1321, 1323 (Fed.Cir. 1990). Claim 5 is not subject to rejection under 35 U.S.C. § 103 because it would not have been obvious to one skilled in the art to combine the teachings of Goodman and Haley to solve the problem addressed by applicant, because none of the cited references address or consider the problems solved by the present invention - maintaining the guide wheels centered within the guide rails to produce smooth motion.

The PTO has a burden under § 103 to establish a *prima facie* case of obviousness. "It can satisfy this burden only by showing some objective teaching in the prior art where that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teaching of the references". In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Applicant respectfully submits that the PTO has not upheld this burden. The applied references have been improperly combined, using hindsight reconstruction, without evidence to support the combination.

Appln No. 09/632,315

Amdt date September 2, 2003

Reply to Office action of April 2, 2003

Moreover, applicant respectfully submits that even if one did attempt to combine the teachings of Goodman and Haley, the present invention as claimed in claims 5 and 48, would not result because there is no teaching in the art that the biasing member and the (V-shaped) cross section of the raceway center the guide wheel within the raceway.

As such, claim 5 and dependent claims 6 and 8-10, which depend from claim 5, are distinguished from the references of Goodman and Haley, taken alone or in combination.

Independent claim 37 recites the features of "a first raceway having a generally V-shaped cross section" and the feature of "wherein force applied by the biasing member and the shape of the first raceway center the guide wheel within the first raceway". As discussed above in conjunction with claims 5 and 48, claim 37 therefore includes features neither disclosed nor suggested by the reference of Goodman. Since there would be no motivation whatsoever for one of ordinary skill in the art to combine the teachings of Goodman with those of Haley, as discussed above, and since the result would still be distinguished from the combined references, independent claim 37 is also distinguished from the references of Goodman and Haley, taken alone or in combination.

Therefore, the rejection of claims 6, 8-10 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Goodman in view of Haley, should be withdrawn.

Appln No. 09/632,315
Amdt date September 2, 2003
Reply to Office action of April 2, 2003

VI. Rejection of Claim 7 Under 35 U.S.C. § 103(a)

In the subject Office action, particularly in paragraph 6, claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Goodman. Applicant respectfully submits that this claim rejection is overcome based on the reasons set forth below.

Claim 7 is a dependant claim which depends from claim 5 which is distinguished from the Goodman reference for reasons set forth above. The Office action states that "It would have been obvious to one of ordinary skill in the art to modify Goodman to provide a second raceway spaced apart from the first". Even if true, such feature would not make up for the above-state of deficiencies of Goodman. Therefore, the rejection of claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Goodman, should be withdrawn.

VII. Rejection of Claims 11-13 and 38 Under 35 U.S.C. § 103(a)

In the subject Office action, particularly in paragraph 7, claims 11-13 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Goodman in view of Bach, et al. (U.S. Patent No. 5,373,791), hereinafter "Bach". Applicant respectfully submits that these claim rejections are overcome based on the reasons set forth below.

Claims 11-13 each depend, directly or indirectly from independent claim 5 which is distinguished from Goodman for reasons set forth above. Claim 38 depends from claim 37 which is also distinguished from Goodman as discussed above. The

Appln No. 09/632,315

Amdt date September 2, 2003

Reply to Office action of April 2, 2003

cited reference of Bach has apparently been relied because "Bach teaches wheels having a large diameter section and a smaller diameter section". The Office action further states that "it would have been obvious to one of ordinary skill in the art to modify Goodman to shape the wheels as desired such as taught by Bach to help maintain the wheels within the guide rails".

Applicant first points out that Bach is directed to a toy wheel for a model electric train and that there would be no motivation to one of ordinary skill in the art to combine the teachings of a massage table with the teachings of toy wheel for a model electric train. Moreover, the toy wheel of Bach does not make up for the above-stated deficiencies of Goodman. Since claim 5 (from which claims 11-13 depend) and claim 37 (from which claim 38 depends) are each distinguished from Goodman for reasons set forth above, and because Bach does not make up for the above-stated deficiencies of Goodman, claims 5 and 37, and therefore claims 11-13 and 38, are distinguished from the references of Goodman and Bach, taken alone or in combination.

Therefore, the rejection of claims 11-13 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Goodman in view of Bach, should be withdrawn.

VIII. Claim 14

Claim 14 was not specifically addressed in the subject Office action, but in the Office Action Summary sheet, claim 14 was listed as being rejected. Since claim 14 depends from claim 5 which is distinguished from the references of record for

Appln No. 09/632,315
Amdt date September 2, 2003
Reply to Office action of April 2, 2003


reasons set forth above, applicant respectfully submits that claim 14 is also in allowable form.

CONCLUSION

Based on the foregoing, each of claims 1, 3-14, 37-39, 46 and 48 are in allowable form and the application is therefore in condition for allowance, which action is respectfully and expeditiously requested.

Respectfully submitted,
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MJM/dlf

Enclosures: Interview Summary Dated May 16, 2003
Figure 23

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